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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/689,124
Filing Date: October 20, 2003
Appellant(s): FALAHEE, MARK H.

John G. Posa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/29/2008 appealing from the Office action mailed 10/29/2007, and the order returning undocketed appeal to the examiner from BPAI dated 06/03/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. Appellant only mentions claims 2 and 13 which have been amended and claim 15 which has been cancelled, in the after final amendment dated 04/29/2008. The status of claims should be Claims 1-14 and 16 under appeal, Claims 1-14 and 16 rejected, and Claim 15 cancelled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|---------|---------|
| 6,689,103 | PALASIS | 02-2004 |
| 6,198,807 | DESENA | 03-2001 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8 and 10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by

Palasis (U.S. Patent No. **6,689,103**).

Claims 1-8, 10-13: Palasis discloses a marker comprising a housing **22** in the form of a marking pen and a reservoir **26** in the housing that is filled with a substance or "contrast solution" ink which, when dispensed through the marking pen is radiopaque, the ink being visible to the human eye and capable of marking human skin or commercially available surgical film. The substance includes a heavy metal, such as barium and is primarily a liquid and is erasable, biocompatible, and non-toxic. Palasis discloses providing the marking pen of Claim 1 and indicating an operative site using the marking pen and subjecting the site to x-ray exposure ("fluoroscopic equipment") for the purpose of comparing the indication to one or more internal structures associated with the procedure (Figure 1, col. 7, lines 48 to col. 8, line 15, col. 9, lines 1-4, col. 11, lines 12-23).

Claims 9, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Palasis (U.S. Patent No. **6,689,103**) in view of **DeSena** (U.S. Patent No. **6,198,807**).

Claims 9, 14, 16: Palasis discloses the claimed device except for the substance being primarily a powder and the step of indicating an operative site using the marking pen

includes marking a surgical film and erasing an indication if not optimized for the procedure.

DeSena teaches a radiopaque substance being primarily a powder and the step of indicating an operative site using the marking pen includes marking a surgical film **36** (Figure 5, col. 3, lines 45-60, col. 6, lines 18-48, col. 7, lines 22-39). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a powdered substance and marking a surgical film, as taught by DeSena, since it was known in the art that powder is minimally invasive and easily removed from the skin or surgical film when undesired, and that using a marked surgical film is also minimally invasive and easily removed from the surgical site being x-rayed. Although DeSena does not teach erasing an indication if not optimized for the procedure, it would have been obvious to one of ordinary skill in the art since it was known in the art that the ink is erasable and commonplace errors in marking may be conveniently corrected by erasing them. It is noted that in the Final office action dated 10/29/2007 on page 4, paragraph 7 that claim 16 was not listed - however the paragraph clearly indicates the limitation of claim 16 "erasing an indication if not optimized for the procedure," and therefore has been rejected, and therefore there are no new grounds of rejection.

(10) Response to Argument

Appellant generally argues that the examiner's interpretation of the device shown in Figure 1 of Palasis representing a marking pen is unreasonable, since the flexible sheath "housing" 22 of Palasis is a departure from what one of ordinary skill in the art would consider a marking pen to be, in its ordinary and customary meaning: "a pen-shaped implement used to mark things," as defined by the appellant in the last paragraph of page 4 of the brief. However, the device in Figure 1 of Palasis is characterized by an elongate, cylindrical, or pen-shaped member 22 with a reservoir 52 and a distal tip through which a substance is dispensed to mark tissue, and therefore the device of Palasis reads on this ordinary and customary definition.

Appellant also asserts that the device of Palasis is not capable of marking skin or surgical film or an operative site because the fluid of Palasis would flow over a patient's body, thereby precluding use as an ink for marking. However, the fluid is still capable of marking, or making a visible trace or impression of the fluid on skin or surgical film after being dispensed.

Appellant also argues that Palasis does not disclose a reservoir in the housing. The examiner disagrees. The device of Palasis clearly stores the radiopaque substance within the housing 22 or 52 of the device (col. 7, line 48 to col. 8, line 15).

Appellant is unclear as to what the examiner meant in the rejection of claims 9 and 14 regarding powder being an obvious modification of the fluid substance because it is "minimally invasive." As mentioned in the rejection, the examiner clarified that the motivation for modifying the fluid substance of Palasis by using powder was for the

substance to be "easily removed from the skin or surgical film when undesired" or "easily removed from the surgical site being x-rayed," and not necessarily requiring penetration of the skin.

Lastly, the appellant presumed that no art was applied to the rejection of claim 16. Although not labeled, claim 16 is discussed and rejected under the rejection for claims 9 and 14 involving the "step of erasing the indication if not optimized for the procedure." As maintained in the rejection above, the examiner asserts that "although DeSena does not teach erasing an indication if not optimized for the procedure, it would have been obvious to one of ordinary skill in the art since it was known in the art that the ink is erasable and commonplace errors in marking may be conveniently corrected by erasing them."

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 3734

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Diane Yabut/

Examiner, Art Unit 3734

Conferees:

Todd Manahan

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3734

Marc Jimenez

/Marc Jimenez/

TQAS TC 3700